Remarks

In the non-final Office Action mailed on July 18, 2006, the Examiner rejected claims 1-4, 6-10 and 17-20 under 35 U.S.C. 101 as directed to non-statutory subject matter. More specifically, the Examiner stated that the claimed invention does not produce a tangible result. The Examiner stated that claims 1-4, 6-10 and 17-20 would be allowable if claim language were added that includes outputting, displaying, storing, or otherwise conveying the result of the previous steps. The Examiner stated that claims 11-16 are allowable.

Applicants have amended claims 1 and 17 to overcome the Examiner's rejection and request reconsideration and withdrawal of same.

35 U.S.C. §101 Rejection

The Examiner rejected claims 1-4, 6-10 and 17-20 under 35 U.S.C. 101 as directed to non-statutory subject matter. More specifically, the Examiner stated that the claimed invention does not produce a tangible result. The rejection will be discussed in terms of independent claim 1.

Claim 1 is directed at "[a] method of assessing timing of PCI signals". The method of claim 1 operates to assess timing of PCI signals by initiating a test mode within a host adapter board. A clock signal is generated for the host adapter board. PCI signals are generated within the host adapter board using an I/O controller of the host adapter board. One or more of the PCI signal lines are selected using the I/O controller, and the timing of one or more PCI signals from the PCI signal lines are assessed. The assessment for example may then be reported and used for verifying proper operation of the host adapter board. For example, the verification may ensure that the timing of the PCI signals conform to PCI timing specifications.

In paragraphs 0002 and 0003 of the specification, Applicants discuss proper functionality of the host adapter board. Specifically, Applicants discuss reasons for ensuring that PCI signals are within PCI timing specifications. This may include for example, ensuring that the slew rate and clock-to-signal-valid delays of the PCI signal lines conform to the PCI timing specifications. Paragraphs 0023-0025 of the specification

discuss testing PCI signal lines of the host adapter board. For example, step 112 may determine the slew rate, which may be used to determine whether the host adapter board properly operates within the PCI timing specifications. As mentioned in paragraph 0027, the host adapter board may assess the PCI timing signals and report test results from the assessment, for example, to a PCI signal bus.

While Applicants believe that testing the PCI signal lines to assess timing of the PCI signals produces a tangible result, in hopes of further advancing prosecution of the application, Applicants have amended claims 1 and 17. More specifically, Applicants have amended claims 1 and 17 to recite that the assessing step generates test results. Applicants have further amended claims 1 and 17 to recite "reporting the test results for verifying proper operation of the host adapter board". The method of amended claim 1 tests the host adapter board to generate test results by assessing timing of the PCI signals. The test results are useful for verifying proper operation of the host adapter board. The test results may be reported to an operator, the host adapter board or other software utilities for verification. Reporting may include displaying, outputting, storing, transmitting or otherwise giving an account of the test results generated during the assessing step to other devices, software applications or persons for further utilization and verification of the proper operation of the host adapter board. For example, the test results may be used to determine whether the PCI signals of the PCI signal lines are within PCI timing specifications. Thus, amended claims 1 and 17 produce a "tangible" result, i.e., the generated test results, which may be reported and utilized for verification purposes, e.g., for verification of proper operation of host adapter board. Support for this amendment may be found in paragraphs 0023-0025 and 0027 as discussed above. Thus, the amendment does not add new matter to the application.

Applicants submit that amended claims 1 and 17 produce a tangible result, and are thus directed at statutory subject matter. These same arguments apply to independent claim 17 and dependent claims 2-4, 6-10 and 18-20. Applicants respectfully request reconsideration and withdrawal of the rejection.

Conclusion

Claims 1 and 17 have been amended responsive to the Examiner's 101 rejection. Applicants have thoroughly discussed the rejection of the claims and respectfully request reconsideration and withdrawal of all outstanding rejections.

No additional fees are believed due. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

Respectfully submitted,

Max Gratton (Reg. No. 56,541)
Duft Bornsen & Fishman, LLP
1526 Spruce Street, Suite 302
Boulder, CO 80302
(303) 786-7687
(303) 786-7691 (fax)